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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,538	03/31/2004	Steven S. Homer	200313005-1	7413
22879 7590 07/25/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER HOLTON, STEVEN E	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/814,538	Applicant(s) HOMER, STEVEN S.	
	Examiner Steven E. Holton	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-16 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 4/27/2007. Claims 1-21 are currently pending in the application. An action follows below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danis et al. (USPN: 6215480), hereinafter Danis.

Regarding claims 1 and 17, the Examiner notes that these claims are similarly related and can be considered together. Danis discloses a pen device with a cylindrical housing (Fig. 1, element 10) and a weight (Fig. 3, element 32) disposed within the cylindrical housing and rotationally coupled relative to the housing (col. 3, lines 28-46). The weight rotates within the cylindrical housing to measure the rotational energy of the cylindrical housing. Danis does not discuss the amount of friction between the weighted cam and the cylindrical housing; however, the amount of friction between the weight and the cylindrical housing would be set at "a desired level of friction to absorb rotational energy". The amount of friction between the housing and the weight would be selected to a desired level so that the amount of absorbed rotational energy would not

Art Unit: 2629

inhibit the operation of the scrolling of the display text based on the rotation of the weight. The amount of friction between the cylindrical housing and the weight would be set to a relatively low desired level of friction.

Regarding claims 4 and 21, Danis discloses providing a weighted cam rotationally coupled within the cylindrical housing (Fig. 3, element 32; col. 3, lines 28-46). At the time of invention it would be a matter of design choice to construct the weighted cam as a single solid piece or a weight attached to a shaft allowing the weight to rotate around the axis of the shaft. In either arrangement, it would be obvious that the axis of rotation would need to be the longitudinal axis of the cylinder or parallel to that axis. Otherwise, the weighted cam would not rotate in time with the pen housing and the display would not be correctly updated with the motion of the pen. Thus, the weighted cam described by Danis could be altered into a weight coupled to a shaft and would be disposed along the long axis of the cylindrical housing for measuring the rotation of the pen.

Regarding claim 18, Danis discloses providing the weight inside the cylindrical housing to be rotationally moved (col. 3, lines 28-46).

Regarding claims 2, 3, 5-8, 19, and 20, the Examiner notes that friction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along a shaft supporting the weight within the pen device. The location of frictional surfaces could be all 3 or any combination of the surfaces depending on the desired

level of friction and the coefficient of friction provided by the materials selected for construction of the pen.

Response to Arguments

3. Applicant's arguments filed 4/27/2007 have been fully considered but they are not persuasive regarding claims 1-8 and 17-21.

Regarding claims 1-8 and 17-21, the Examiner agrees that the weight within of Danis is not used to inhibit the rotation of the pen to cause the pen to stop in a rolling motion. However, the weight is held within the cylindrical housing and the amount of friction between the housing and the weight will be set to a desired level to allow for operation of the pen display device. This may result in a low amount of absorption of rotational energy of the cylindrical housing relative to the weight, but that would be the desired amount for operation of the pen display of Danis. Therefore, although Danis is not concerned with stopping the pen from rolling, Danis does select a desired level of friction between the weight and cylindrical housing to allow for operation of the device.

Allowable Subject Matter

4. Claims 9-16 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The present invention is directed to a pen with a weight disposed within the housing to inhibit rolling of the pen by friction between the pen body and the weight.

Claim 9 identifies the uniquely distinct features "a frictional element adapted to inhibit movement between the weight and the cylindrical housing". The closest prior art, Danis disclose discloses a weight within a cylindrical housing but it is not expressly adapted to inhibit movement between the two elements and fails to anticipate or render the above underlined limitations obvious. Further, the Applicant's arguments filed on 4/27/2007 regarding the differences between Danis and the claimed invention are taken in consideration.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven E. Holton whose telephone number is (571) 272-7903. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Steven E. Holton
Division 2629
July 22, 2007

AMR A. AWAD
SUPERVISORY PATENT EXAMINER

